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IN THE

Supreme Court of the United States

October Term, 1943.

No. 455

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LEROY J. LEISHMAN,

Petitioner,

vs.

ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

Respondent.

Petition for Writ of Certiorari and Brief in Support Thereof.

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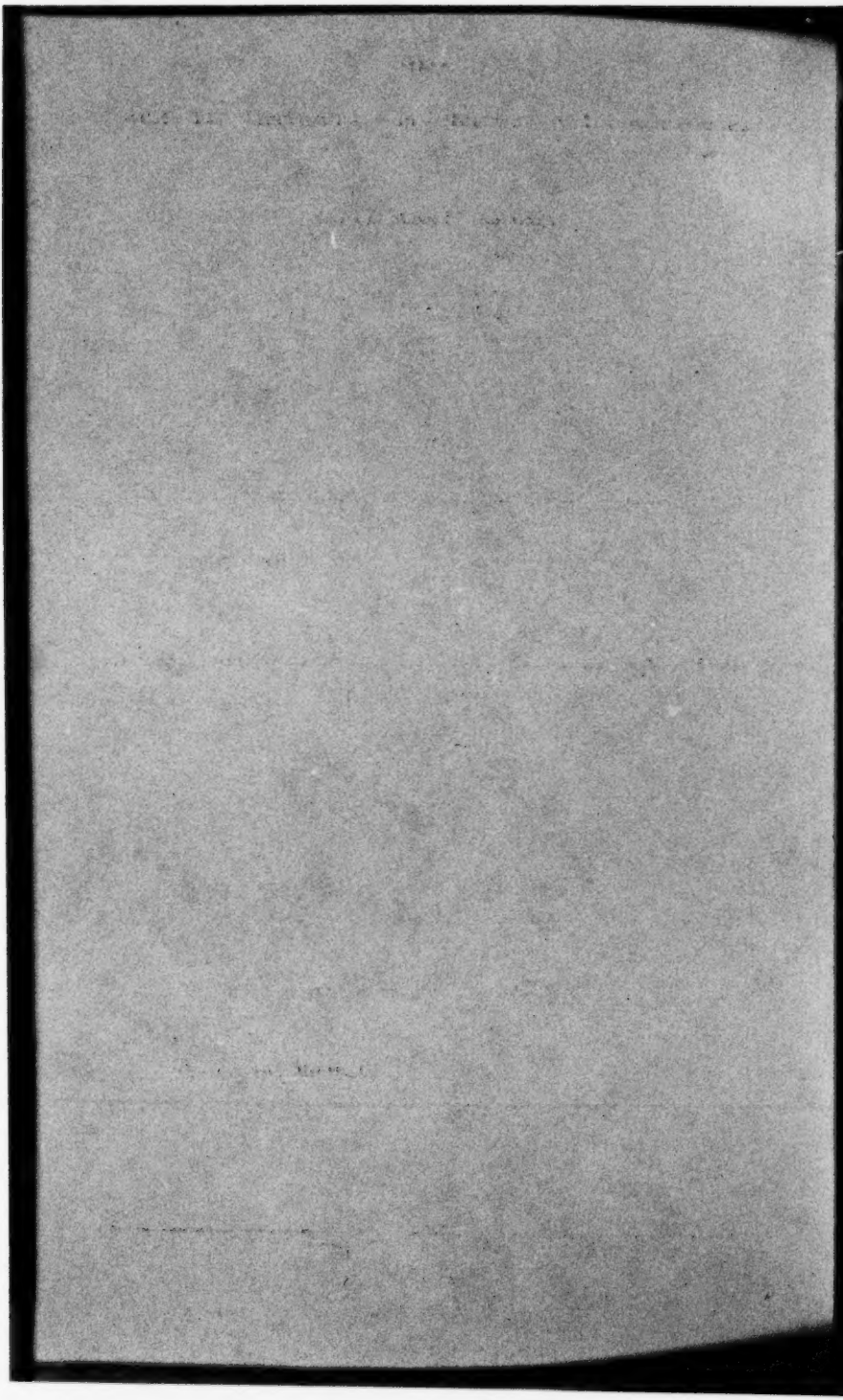

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LEROY J. LEISHMAN,

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ASSOCIATED WHOLESALE ELECTRIC COMPANY, a corporation,

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PETITION FOR WRIT OF CERTIORARI.

To the Honorable Supreme Court of the United States:

Your petitioner respectfully shows:

Statement of the Matter Involved.

LeRoy J. Leishman, petitioner herein, brought this suit in the United States District Court for the Southern District of California, against Associated Wholesale Electric Company, a corporation, respondent herein.

The petitioner alleged that respondent infringed Reissue Letters Patent No. 20,827 [R. Vol. I, pp. 2 *et seq*].

The respondent, among other defenses, urged that the claims at issue were invalid for want of invention; that the reissue patent was invalid because it was granted for an invention other than that secured by the original patent;

and that the respondent did not infringe the claims at issue. These defenses were set out in the respondent's answer [R. Vol. I, pp. 6 *et seq.*].

After a trial, a final judgment was entered, dismissing the complaint on the ground that the claims at issue were invalid for want of invention [R. Vol. I, pp. 38 *et seq.*].

An appeal was taken from the judgment, which the Circuit Court of Appeals dismissed on May 26, 1942 [R. Vol. IV, pp. 688, 689], on the ground that the appeal was not taken in time. A petition for a writ of certiorari was granted by this Honorable Court on October 12, 1942 [R. Vol. IV, p. 692]. On February 15, 1943, this Honorable Court reversed the decision of the Circuit Court of Appeals [R. Vol. V, p. 695]; and on August 12, 1943, the Circuit Court of Appeals rendered its opinion on the merits of the case. In that opinion, the judgment of the District Court was modified, and dismissal of the complaint was affirmed [R. Vol. V, p. 717]. As will be pointed out hereinafter, that opinion is in conflict with that in *Monogram Mfg. Co. v. Glemby Co., Inc., et al.*, 136 F. (2d) 961, and with former opinions of this Court.

The reissue patent in suit [R. Vol. III, pp. 508 *et seq.*], like the original patent [R. Vol. III, pp. 514 *et seq.*] as stated in the objects, relates to a mechanism for tuning "either a radio set or a television set, or both," "by a simple manually operated control." This is accomplished in such manner that, when a force is applied to the manual operating member, the mechanism finally reaches and maintains a position that corresponds to a tuned-in position for a selected transmitting station, or, if both radio and television are involved, for a pair of such stations. The operation of the mechanism is readily understood from an in-

spection of Figs. L-1 to L-5, inclusive, of Plaintiff's Exhibit 24 [R. Vol. III, p. 536]. A lever F is shown as the manually movable operating member. It carries a tappet 61, referred to as a positioning element, that co-operates with a rocker 48 carried by a shaft S that is connected to the tuning condenser.

Downward movement of lever F causes the tappet 61 to urge the rocker 48 to a definite angular position, corresponding to the adjusted position of the tappet (Fig. L-5). Further movement of the lever F and rocker 48 is arrested by the complete engagement of the tappet arms with both sides of the rocker.

The original patent contained five relatively narrow claims directed to the double use of the invention requiring two tappets and rockers, and in which the manual operating means for bringing the tappet into engagement with the rocker was referred to as a lever; and it contained a broad claim (claim 5, which was later disclaimed from the reissue) directed to a single tappet and rocker, and this claim did not even include the operating means as an element of the combination.

Claim 5 of the original patent read as follows (the parts of the device being referred to parenthetically for the convenience of this Court by the reference numerals used in the patent):

> "5. The combination with the tuning mechanism of a radio apparatus; of a rotatable rocker (48) mounted upon a shaft (S) operatively connected with said mechanism, said rocker having two arms each extending on a different side of said shaft; means (the tappet 61) movable about a pivot (60) and acting upon operation in one direction to slidably engage either arm of said rocker and push it in one direction

to an angular position at which the movement of said rocker is arrested by the collision of said means and the oppositely moving other arm of said rocker; and a spring for holding said means in a normally inoperative position."

Because the kind of means for bringing the tappet into engagement with the rocker is immaterial to the invention, this claim was confined to the essential elements—the rocker, the tappet, and a spring acting to hold the tappet normally away from the rocker.

The reissue patent contained all the claims of the original, including claim 5, and added claims 7, 8, 9, 10, 11 and 12, patterned after claim 5, but having various limitations and qualifications directed chiefly to structural features of the rocker and tappet and their specific coaction, as disclosed in the original specification and drawings.

Claims 7 and 8, like claim 5, do not call for a lever nor anything that can even be construed as an equivalent.

Regarding the rocker and tappet, the Court of Appeals says [R. Vol. V, p. 715]: "The accused device * * * has a rocker which is the equivalent of appellant's rocker 48. * * * It has tappets each of which is the equivalent of appellant's tappet 61." And the accused device also contains the spring. All the elements of claims 7 and 8 are thus present, each acting in the manner disclosed, illustrated and claimed. The hitherto accepted requirements for infringement were thus fully met and, moreover, recognized by the Circuit Court.

The District Court had previously said [R. Vol. I, p. 22]:

". . . it cannot be seriously denied that the accused device uses the rotatable rocker, adjustable

> tappet and when brought to rest the two parts are coaxial—*the essential elements contained in the plaintiff's structure.*" (Emphasis added.)

And on page 26, Vol. I, the trial court reiterated: ". . . as I have stated before, it contained plaintiff's combination."

However, the Circuit Court of Appeals in considering the combination covered by the claims at issue, refers to *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation,* 315 U. S. 668, as authority for the unwarranted statement that if claims 7-11 of the reissue patent "do not include levers, the claims are not for the same invention as the original patent and hence are invalid. If they do include levers, the claims are not infringed, for the accused device contains no lever" [R. Vol. V, p. 715].

In formulating this hypothesis, the Circuit Court of Appeals for the Ninth Circuit reiterated the well established principle that a reissue patent must be for the same invention as the original patent [R. Vol. V, p. 702]. The Court then [R. Vol. V, p. 703] propounded the following:

> "Hence the questions here to be considered are whether what is covered by claims 7-11 of the reissue patent was disclosed in the original patent, and whether it appears from the face of the original that what is covered by claims 7-11 of the reissue was intended to have been covered and secured by the original."

The Circuit Court of Appeals [R. Vol. V, pp. 714 *et seq.*] proposes to determine this intent of the petitioner by interpreting the claims of the original patent, despite the obvious fact that it would be pointless to reissue a

patent if the original claims had to be adhered to. That Court points out that all of the original claims mention a lever; but in doing so it had to ignore original claim 5, which it did by misapplication of *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491 [R. Vol. V, p. 702]. The Court does this in the following manner [R. Vol. V, p. 701]:

> "* * * On January 16, 1939, while the action was pending in the District Court, claim 5 was disclaimed in its entirety. Hence both the original patent and the reissue must be construed as if claim 5 had never been included in either (here footnote 6 cites *Dunbar v. Myers*, 94 U. S. 187, 194; *Schwarzwalder v. New York Filter Co.*, 2 Cir., 66 F. 152, 158; *Oliver Machinery Co. v. Gellman*, 6 Cir., 104 F. (2d) 11, 12); for the disclaimer 'speaks from the date of the original patent.'" (Here footnote 7 cites *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491.)

When quoting the original claims for determining intent, and omitting claim 5 entirely from such quotation, the Court in footnote 12 [R. Vol. V, p. 709] further explains: "For reasons heretofore stated, the patent is construed as if claim 5 had never been included therein." In other words, the patent is artificially construed as if it never had described or claimed a combination in which the lever was not included as an element.

Because of this improper application of the decision in *Altoona Publix Theatres v. American Tri-Ergon Corp.*, the Court finds justification for its statement that ". . . nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby." [R. Vol. V, p. 712.]

Since the Court (without considering claim 5 or weighing the objects) thus justifies its interpretation of the invention secured by claims 7-11 as one that necessarily includes a lever, it accordingly comes to its ultimate conclusion that the plunger operated accused device is outside the scope of these claims.

The Supreme Court Has Jurisdiction to Review the Appellate Court's Decision.

Petitioner relies upon Section 240 of the Judicial Code, corresponding to Title 28, U. S. C. A., paragraph 347. There is a conflict in the decision herein sought to be reviewed, and in that of Circuit Court of Appeals for the Second Circuit, in *Monogram Mfg. Co. v. Glemby Co., Inc., et al.*, 136 F. (2d) 961. Furthermore, the decision herein sought to be reviewed is inconsistent with *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, and with *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation*, 315 U. S. 668, in that these decisions have been misinterpreted by the Circuit Court of Appeals in this case.

The Questions Presented.

The real import of the decision of the Ninth Circuit Court is that a reissue patent is not for the same invention as the original unless its added claims include every element mentioned in any and all of the original claims, and identified by the same terms as in the original; and it held to that effect in the instant case even though one of the elements was not stressed in the original as essential to the invention *per se;* and notwithstanding the fact that the original patent contained a claim which did not include this particular element in the combination at all.

Though the Court cites the Supreme Court opinion in the *U. S. Industrial Chemicals* case as authority for the decision complained of, petitioner believes the cited Supreme Court opinion has been misapplied in the present case and that this Honorable Court never intended that its opinion in the *U. S. Industrial Chemicals* case would be construed to mean that reissue claims must not omit any element mentioned in the original claims even if such element was not described as essential.

Faced with a set of facts parallel to those in the instant case, the Second Circuit Court of Appeals ruled that it was not necessary for reissue claims to include an element not stressed in the original as essential, and, after citing the Supreme Court decision in the *U. S. Industrial Chemicals* case in support of its holding, it differentiated the facts in the Second Circuit case from those considered by the Supreme Court in its *U. S. Industrial Chemicals* opinion by stating (136 F. (2d), p. 964):

> "It may be noted that in the Industrial Chemicals case, the element omitted from the issue therefore held invalid was considered essential to the invention by the patentee himself and by the trade generally. That it was dispensable was discovered only by an independent and subsequent experimentation."

One of the questions presented is thus whether or not the Second Circuit or the Ninth Circuit interpretation shall prevail, or, more specifically, whether or not claims added by a reissue must contain every element mentioned in any and all the claims of the original, and identified by terminology that confines each element to the specific embodiment illustrated, in order for the reissue to be for the same

invention—an interpretation which, if permitted to stand, will in large measure nullify the reissue statute and establish a doctrine in conflict with the long accepted practice.

The decision of the appellate court also raises a question as to whether it is permissible, in comparing the original and reissue documents, to omit a claim from the original because such claim was later disclaimed from the reissue.

Petitioner further contends that the Circuit Court of Appeals erroneously interpreted the claims of the reissue patent—an error that leads to freeing the accused device from the charge of infringement.

Another question is presented in that the decision of Ninth Circuit Court is also at variance with the heretofore established principles for determining infringement, for it is clearly an error to hold that a device must include something not mentioned as an element of the combination in a given claim in order to infringe such claim. Such doctrine nullifies the effect of claims altogether.

Petitioner also questions the holding of the Court that the plunger of the accused device is not the equivalent of the lever described in petitioner's patent;[1] on the contrary, petitioner contends that the plunger performs its function of moving the tappet into engagement with the rocker substantially in the same way the lever performs this function. The Circuit Court of Appeals makes the immaterial distinction [R. Vol. V, p. 715, footnote 17] that "Appellant's levers have a double function—that of operating the tappet 61 and that of operating the tappet 62. The latter

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[1]In no case is this holding pertinent to claims 7 and 8, because the manual operating member is not included as an element in these claims.

function is not performed at all in the accused device."[2] Regarding this matter of equivalency, the Court further relies upon its conclusion that petitioner never intended to claim a leverless combination, which, in turn, is based upon an erroneous interpretation of *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra.*

Reasons Relied Upon for Allowance of the Writ.

The Circuit Court of Appeals for the Ninth Circuit has decided an important question of patent law in a way that is in conflict with the decision in *Monogram Mfg. Co. v. Glemby Co., Inc., et al.,* decided by the Circuit Court of Appeals for the Second Circuit, and reported at 136 F. (2d) 961.

This conflict arises from the divergent interpretations of the decision of this Honorable Court in *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation,* 315 U. S. 668. In that case, a step in a chemical process was stressed in the original patent as essential; but, in the reissue, the step was treated as immaterial. On this basis, clearly the requirement prescribed by this Honorable Court that "It must appear from the face of the instrument that what is covered by the reissue was intended to have been covered and secured by the original" was not met.

The Circuit Court of Appeals for the Ninth Circuit in the instant case improperly applies this doctrine in its manner of reaching the conclusion [R. Vol. V, pp. 711, 712]

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[2]This is not a valid distinction, for both the original and reissue patents state that one of the objects is "to make it possible for a single manual operation to tune either a radio set or a television set, or both."

that "No leverless combination is disclosed or claimed in the original patent, nor does it appear from the face thereof that any leverless combination was intended to have been covered or secured thereby." And in so evaluating the intent of the petitioner, the Court failed to give any consideration to two factors: (1) That the objects recited in the original patent do not indicate that the lever *per se* is a necessary element; but on the contrary, each time the operation, or the operating means, is referred to in the objects (which is five times in all), broad terms are used, to wit [R. Vol. V, pp. 703, 704, 705]: "a simple manually operated control," "a single manual operation," "a single manual operation," "a definite manual operation," and "a single manual operation"; and (2) that claim 5 of the original patent did cover a leverless combination, and is clear evidence that petitioner intended to claim such a combination.

The Circuit Court of Appeals for the Second Circuit discussed the doctrine of the *U. S. Industrial Chemicals* case. In this Second Circuit case, the reissue patent disclosed a hair curler that utilized a spring, but this spring, like the lever in the instant case, was not stressed as essential to the invention. In coming to the conclusion that claims omitting the spring were drawn to the same invention as the original patent, the Court states (pp. 963, 964):

> "Defendants contend that the claims of the original patent required a spring between the arms of the curler as a means of clamping the hair and holding it for the winding process, and that the reissue, in adopting all the original claims, but adding several which omitted the spring, was for a different invention. The court below found that Visitacion himself

did not intend any such limitation in the original as that contended for and had so informed his lawyers. That alone cannot be conclusive, since the test must be what was fairly disclosed as essential in the original. This is made clear by the latest case on the subject, United States Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corp., 315 U. S. 668, 677, 62 S. Ct. 839, 844, 86 L. Ed. 1105, where the Court said: 'We think it plain that the reissue omitted a step in the process which was described and claimed as essential in the original patent.' Hence, does the original patent here, fairly and reasonably interpreted, describe and claim the spring as an essential part of the curler?

The argument for such a reading is, of course, the obvious fact that the drawings of the original patent do depict, and the specifications describe, such a spring, either as a separate spring wire fitted between the arms of the curler or cut from the shorter arm,[3] and that all of the seven original claims except one describe such a spring as a part of the appliance.[4] But there are several reasons for rejecting so purely literal a reading. First, the patent itself, in three opening paragraphs stressing the objects of the invention, makes no reference in any way to any device requiring a spring.[5] The first paragraph states that 'an object of the invention is to provide an efficient

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[3]So, in the instant Ninth Circuit case, the drawings of the original patent do depict, and the specifications describe, a lever.

[4]So, in the instant case, all except one of the original claims (claim 5) describe a lever as a part of the appliance.

[5]So, in the instant case, the opening paragraphs stressing the objects of the invention, make no reference in any way to any device requiring a lever.

hair curling implement to which the ends of hair strands are secured upon a tubular mandrel, thereafter coiled by winding thereon as closely as possible to the scalp,' and continues to describe the process by which the coils are slipped from the mandrel between the prongs of a bobby pin carried by the mandrel in open position—all without reference to a spring.[6] The second paragraph stresses the easy operation of the instrument, subjected to heat without damage, readily cleansed, capable of long service and of such simplicity as to be inexpensive to construction.

* * * In the light of this background it seems harsh to hold the spring clamp as anything more than at most a 'preferred embodiment.' It may be noted that in the Industrial Chemicals case, the element omitted from the issue therefore held invalid was considered essential to the invention by the patentee himself and by the trade generally. That it was dispensable was discovered only by an independent and subsequent experimentation."

In neither the Ninth or Second Circuit cases, is the disputed element of the combination stressed as essential in the original patent. Yet the Ninth Circuit Court, in evaluating the intent of the patentee and faced with facts parallel to those in the Second Circuit case, comes to a conclusion diametrically opposite to that of the Second Circuit Court. Thus we have two conflicting decisions interpreting the Supreme Court opinion in *U. S. Industrial Chemicals, Inc., v. Carbide & Carbon Chemicals Corporation, supra.*

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[6]In the instant case, the objects mentioned "a simple manually operated control," "a single manual operation" and "a definite manual operation"—all without reference to a lever.

Another reason relied upon for the granting of the petition is that the Circuit Court of Appeals for the Ninth Circuit improperly ignores claim 5 appearing in the original patent. As authority for this, the Court cites *Altoona Publix Theatres v. American Tri-Ergon Corp.*, 294 U. S. 477, 491, wherein it is briefly stated that a patent amended by disclaimer speaks from the date of the original patent. To interpret this brief statement to mean that a disclaimed claim cannot be considered on the question of intent on the part of the patentee is clearly contrary to the meaning of that Supreme Court case.

To hold that a claim of the original patent which has been deleted from the reissue is not to be taken into consideration in determining what the patent reveals on its face and what the patentee sought to cover, is a holding that is totally without precedent; and it involves a point of law, in addition to the question already posed, on which this Honorable Court has never passed, but which this Honorable Court should review because of its far reaching effect upon future reissue patents as well as upon those already granted and now in force.

Prayer for the Issuance of the Writ.

Wherefore, your petitioner prays that a writ of certiorari issue under the seal of this Court, directed to the United States Circuit Court of Appeals for the Ninth Circuit, commanding said Court to certify and send to this Court a full and complete transcript of the record and of the proceedings of the said Circuit Court had in the case numbered and entitled on its Docket No. 9970, LeRoy J. Leishman, appellant, vs. Associated Wholesale Electric Company, a corporation, appellee, to the end that this cause may be reviewed and determined by this Court as provided by the statutes of the United States; and that the judgment herein of said Circuit Court of Appeals for the Ninth Circuit be reversed by the Court, and for such other relief as to this Court may seem proper.

Dated this 18th day of October, 1943.

LeRoy J. Leishman,

By John Flam,

Counsel for Petitioner.

Certificate.

This petition is in my judgment well grounded, and is not interposed for delay.

John Flam.

Counsel for Petitioner.